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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,880	11/23/2005	Martin Burgbacher	095309.55997US	2235

23911 7590 05/29/2008
CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

KNIGHT, DEREK DOUGLAS

ART UNIT	PAPER NUMBER
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3681

MAIL DATE	DELIVERY MODE
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05/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,880	Applicant(s) BURGBACHER, MARTIN	
	Examiner DEREK D. KNIGHT	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 21-23 and 25-27 is/are allowed.
- 6) ☐ Claim(s) 15, 16, 18-20, 24 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 16, 18-20, 24 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is a single claim which claims both an apparatus and the method steps (lines 19-27) of using the apparatus; see MPEP 2173.05(q; II).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15,16,18-20, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by **MICHIHIRA et al. (US 5,094,115)**.

Regarding claim 15: MICHIHIRA discloses a gear selection device for an automatic transmission of a motor vehicle, which has an actuator (22B), a drive element (23i), a driven element (26), at least one actuation element (28) and an emergency actuation device (38), wherein: in normal operation, the actuator is drive-connected to the actuation element via the drive element and the driven element, for selection of a gear of the automatic transmission.

The following recitation is functional and does not make the claim structurally distinguishable from the prior art and therefore is given no patentable weight; see MPEP 2114 regarding functional recitations in apparatus claims.

“...forces or torques that are transmissible acting between the drive element and the driven element are limited by predeterminable force or torque limit values; in emergency operation, during which a failure occurs in the gear selection device, the emergency actuation device is operable to exert on the driven element forces or torques which are higher than the force or torque limit values...”

The following recitation is a series of method steps in an apparatus claim and is therefore given no patentable weight.

“...in response to said forces or torques exerted by the emergency actuation device, the drive connection of the actuator to the actuation element is released such that the driven element moves relative to the drive element, and the emergency actuation device drives said actuation element; directly after termination of said emergency operation of the gear selection device, forces or torques can be transmitted, in accordance with the actuator, between the drive element and the driven element.”

Regarding claim 16: MICHIHARA discloses a gear selection device for an automatic transmission of a motor vehicle, wherein: a gear "P" can be set by means of the gear selection device; and a parking lock can consequently be engaged by means

of the driven element. As long as the clutch (34) is engaged it is not possible for the driven element to be moved unless the actuator is activated.

Regarding claim 18: MICHIHIRA discloses a gear selection device for an automatic transmission of a motor vehicle, wherein: only the gear "P" can be engaged by means of the emergency actuation device. This is the case when moving in the counter clock-wise direction from the gear "R".

Regarding claim 19: MICHIHIRA discloses a gear selection device for an automatic transmission of a motor vehicle, further comprising an emergency release device (50), by which the gear "P" can be disengaged.

Regarding claim 20: MICHIHIRA discloses a gear selection device for an automatic transmission of a motor vehicle, wherein: at least one of the emergency actuation device and the emergency release device can be actuated by a vehicle driver, who is in a driver's seat.

Regarding claim 24: MICHIHIRA discloses a gear selection device for an automatic transmission of a motor vehicle, wherein: a position of the driven element can be detected by a control device by means of a position sensor (36B), see Fig. 2A.

Regarding claim 28: MICHIHIRA discloses a gear selection device for an automatic transmission of a motor vehicle, wherein: the drive element (23i) comprises a single piece with an element (motor output shaft) of the actuator.

Allowable Subject Matter

Claims 17, 21-23 and 25-27 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 15,16,18-20, 24, and 28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEREK D. KNIGHT whose telephone number is (571)272-7951. The examiner can normally be reached on Mon - Thurs & every other Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone

Art Unit: 3681

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D. K./
Examiner, Art Unit 3681

/CHARLES A. MARMOR/
Supervisory Patent Examiner, Art
Unit 3681